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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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LERNER DAVID LITTENBERG
KRUMHOLZ & MENTLIK LLP
600 SOUTH AVENUE WEST
WESTFIELD NJ 07090

QM22/0815

EXAMINER

PELLEGRINO, B

ART UNIT

PAPER NUMBER

3738

7

DATE MAILED:

08/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/388,726

Applicant(s)
An et al.

Examiner
Brian Pellegrino

Group Art Unit
3738



☒ Responsive to communication(s) filed on Sep 2, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) 34-40 is/are withdrawn from consideration.

☒ Claim(s) 27-33 is/are allowed.

☒ Claim(s) 1-3 and 5-26 is/are rejected.

☒ Claim(s) 4 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4-6

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-33, drawn to an expandable or telescoping device, classified in class 623, subclass 17.15.
 - II. Claims 34-40, drawn to a method of inserting a vertebral expansion device, classified in class 606, subclass 90.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the device of Group I can be used for expanding bones other than the vertebrae, i.e. the femur or humerus.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Additionally, a different search is required.
4. During a telephone conversation with Kimberly Perry on 7/27/00 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 34-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 U.S.C. § 112

6. Claims 6-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the "second member" can be "received in a passageway of said first member" since the claim (5) preceding, dependent claim 6, recites that "at least one" of the two members "comprises a hollow member." If the limitation of claim 5 remains as "at least one" of the members contain a hollow chamber and the second member comprises that hollow member than the first member would have to be received in the second member which is the opposite of what claim 6 recites.

Claim Rejections - 35 U.S.C. § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3, 5, 6 as best understood, 8, 9, 15, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers (5336223). It can be seen in Fig. 1 that the device has a first member 2 including a tubular member 10 with a hollow chamber 11 and a second member 1 with an anchored rod 5 that telescopingly enters the cavity 11, col. 2, lines 52-55. It can also be seen that a locking clip in the form of a collar 6 engages with the first and second members (5, 10) via the interengaging threads seen on the said members. Figure 1 also teaches that the "locking clip" contains a "bore, 9" for a screw to lock the "clip" in place. See also col. 2, lines 57-64 teaching that the first member can also contain a corresponding hole for a screw. Regarding claims 15 and 18, Fig. 2 teaches that a first member 5 has an outer tubular member 1 with a passage 3 for engaging an inner tubular member 6 which attaches to second member 10.

9. Claims 1, 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Jeanson et al. (DE 19604246). It can be construed that (Figs. 1-3) a second member 1 containing a ridge 8 engages with a locking clip 4 that contains a depression 12, with the locking clip 4 also engageable with a first member 2 of which it is positioned on. The device can be locked in position via the sawtooth corresponding threads on the elements (1, 2).

10. Claims 1, 5, 6 as best understood, 10, 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Biedermann et al. (WO 96/37170). It can be seen in Fig. 1 that a first member 7 engages with a "locking clip" 3 of which also engages a second member 9. The first and second

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members have a passageway that the "clip" is telescopingly received therein. It can be construed that the one member is telescopingly received within the other since they are attached to the clip. It can also be seen that the two members (7, 9) contain perforations for permitting ingrowth of bone, tissue, etc. The apertures in the members inherently can be used for packing material to encourage bone or tissue growth.

11. Claims 1, 5, 6 as best understood, 10, 12, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Saggar (5702455). It can be seen (Fig. 1) that the spinal fusion device contains a first member 2 engageable with a second member 3 having a hollow tubular member 1 telescopingly received in the first member 2. It can be construed that an adjustable member 4 can be locked in a locked position and engages the first and second members (2, 3) via the hollow member 1 that contains threads. Bone fragment receiving apertures (6, 6') can be seen in the first and second members respectively, col. 3, lines 50-52. Regarding claim 12, it can be construed (Fig. 3) that bone growth encouraging material is inserted in the cavities via apertures (6, 6'), see col. 3, lines 66-67. Figure 3 also teaches that axially extending teeth 9 protrude from first and second members, see col. 3, lines 53-55.

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12. Claims 1, 5-8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Daher (4657550). It can be seen in Fig. 2 that a vertebral device having first and second members (1, 8) with the second member "capable of being telescopingly received" in the hollow opening 6 of first member 1. It can be construed that element 20 is a "locking clip" which locks the two members in position transverse to the longitudinal axis. The "locking clip" is movably mounted on first member 1 in bore 21. It can also be seen that perforations 22 exist on the body of first member and it can be construed that second member's (8) threads can be in the form of perforations.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chen et al. (5575790) show a drive mechanism with a first tubular portion that telescopingly receives a second tubular portion and a retaining ring that has a screw engaged thereto.

Allowable Subject Matter

14. Claims 11, 14, 16, 17, 19-26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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15. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


16. Claims 27-33 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


Brian E. Pellegrino


Michael J. Milano
Primary Examiner
TC 3700, AU 3738

July 31, 2000